

REMARKS

Applicants note that the Examiner has indicated that claims 14, 18 and 21-27 are pending. Applicants respectfully submit that this is incorrect. The Examiner should note that claim 16 is also pending. Accordingly, claims 14, 16 and 23-27 are pending and stand ready for further action on the merits. Claims 18, 21 and 22 have been cancelled. Claims 26 and 27 have been added to further define the scope of the present invention. No new matter has been added by way of the above-amendments.

Issues Under 35 U.S.C. §112, first paragraph

Claims 14, 18 and 21-25 are rejected by the Examiner under 35 U.S.C. §112, first paragraph. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Briefly, Examiner's position is that the claims contain subject matter which is not described in the specification. The Examiner asserts that the instant specification supports the definition of hydrocarbon gel as defined in Japanese Pharmaceutical Excipients submitted in Paper No. 22. The Examiner alleges that the examples in the specification define hydrocarbon gel as Japanese Pharmaceutical Excipient. However, the Examiner concludes there is no support that they are indeed the same because Applicants have not defined the gel in the originally filed specification.

Applicants respectfully submit that the Examiner's position is incorrect. In this regard, the Examiner should note the description at page 5, lines 22-23 of the specification. Moreover, the specification need not teach what is already known in the art. Accordingly, the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn by the Examiner.

Rejection of Claims 14, 18, 21, 22 and 25 under 35 U.S.C. 102(e) over U.S. Patent 5,916,918 to Konishi et al.

Claims 14, 18, 21, 22 and 25 are rejected by the Examiner under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,916,918 to Konishi et al. for the reasons set forth on page 3 of the Office Action. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The Examiner's position is that the Konishi et al. reference discloses an ointment containing 2 g acetylsalicylic acid and 98 g plastibase (example 14). The Examiner further alleges that the slight amount of ethanol is evaporated to yield a composition consisting of acetylsalicylic acid and a hydrocarbon gel only.

The Examiner should note that Examples 15 and 16 of Konishi et al. are similar to Example 14 except that the amount of acetyl salicylic acid is slightly higher. Also, Konishi et al. generically

teach a maximum of 15 wt% of acetyl salicylic acid in column 2, lines 49-58.

Claim 14 has been amended such that the range of the concentration of acetyl salicylic acid is limited to 20 to 30% by weight when the base is a hydrocarbon gel or a mixture of a hydrocarbon gel and petrolatum. Accordingly, the rejection of claims 14, 18, 21, 22 and 25 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,916,918 to Konishi et al. should be withdrawn by the Examiner.

Rejection of Claims 14, 18, 21, 22 and 23 under 35 U.S.C. 102(b) over JP 62267232

Claims 14, 18, 21, 22 and 23 are rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by JP 62267232 for the reasons set forth on page 3 of the Office Action. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The Examiner's position is that JP 62267232 discloses a composition containing 5% aspirin and petrolatum.

Accordingly, claim 14 has been amended to recite that when the base is petrolatum, the acetyl salicylic acid is in a range of 25 to 30% by weight. Therefore, the rejection of claims 14, 18, 21,

22 and 23 under 35 U.S.C. 102(b) as being anticipated by JP 62267232 should be withdrawn by the Examiner.

Rejection of Claims 23 and 24 under 35 U.S.C. 103(a) over U.S. Patent 5,916,918 to Konishi et al.

Claims 23 and 24 are rejected by the Examiner under 35 U.S.C. 103(a) as being obvious over U.S. Patent 5,916,918 to Konishi et al. for the reasons set forth on page 4 of the Office Action. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The Examiner has taken the position that it would be obvious to replace the plastibase of the ointment of Example 14 with Vaseline, since Konishi et al. teach that Vaseline is a possible base for the ointment, see column 3, line 8.

Accordingly, claim 14 has been amended to address this matter raised by the Examiner. Dependent claims 23 and 24 are allowable for the same reasons as claim 14 from which they depend. Thus, the rejection of claims 23 and 24 under 35 U.S.C. 103(a) over U.S. Patent 5,916,918 to Konishi et al. for the reasons set forth on page 4 of the Office Action should be withdrawn by the Examiner.

Rejection of Claim 24 under 35 U.S.C. 103(a) over JP 62267232 Alone
or In View of U.S. Patent 4,794,107 to Takashima et al.

Claim 24 is rejected by the Examiner under 35 U.S.C. 103(a) as being obvious over JP 62267232 alone or in view of U.S. Patent 4,794,107 to Takashima et al. for the reasons set forth on page 4 of the Office Action. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Claim 14 has been amended to recite that when the base is petrolatum, the acetyl salicylic acid is in a range of 25 to 30% by weight. Moreover, claim 24 is allowable for the same reasons as claim 14 from which it depends. Accordingly, the rejection of claim 24 under 35 U.S.C. 103(a) as being obvious over JP 62267232 alone or in view of U.S. Patent 4,794,107 to Takashima et al. for the reasons set forth on page 4 of the Office Action should be withdrawn by the Examiner.

Rejection of Claim 25 under 35 U.S.C. 103(a) over JP 62267232 Alone
or In View of U.S. Patent 4,164,563 to Chang

Claim 25 is rejected by the Examiner under 35 U.S.C. 103(a) as being obvious over JP 62267232 alone or in view of U.S. Patent 4,164,563 to Chang for the reasons set forth on page 5 of the

Office Action. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Applicants respectfully submit that the combination of JP '232 and Chang is improper. Even though Chang suggests the addition of medicaments (column 6, lines 34-39), Chang does not fairly suggest the use of acetyl salicylic acid to be used in the ointment.

Moreover, claim 14 has been amended to recite that when the base is petrolatum, the acetyl salicylic acid is in a range of 25 to 30% by weight. That is, claim 25 is allowable for the same reasons as claim 14 from which it depends. Accordingly, the rejection of claim 25 under 35 U.S.C. 103(a) as being obvious over JP 62267232 alone or in view of U.S. Patent 4,164,563 to Chang for the reasons set forth on page 5 of the Office Action should be withdrawn by the Examiner.

Rejection of Claims 14, 18 and 21-24 Under 35 U.S.C. 103(a) Over GB 2144326 (hereinafter GB '326)

Claims 14, 18 and 21-24 are rejected by the Examiner under 35 U.S.C. §103(a) as being obvious over GB '326. Applicants respectfully traverse the rejection.

The Examiner is improperly equating white soft paraffin (see page 1, lines 67-75 of GB '326) with the inventive white petrolatum. GB '326 fails to teach or suggest the inventive

- composition which contains only acetyl salicylic acid and petrolatum, hydrocarbon gel and mixtures thereof.

Moreover, the amendment limiting the concentration of the acetyl salicylic acid further distinguishes the present invention from GB '326. Thus, the rejection is without basis and must be withdrawn.

Conclusion

In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance.


Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If the Examiner has any questions concerning this application, he is requested to contact the undersigned at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Marc S. Weiner, #32,181

MSW/rem
0020-4518P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please cancel claims 18, 21 and 22 without prejudice to or disclaimer of the subject matter contained therein.

Please amend the claims as follows:

14. (Three Times Amended) An ointment consisting of acetyl salicylic acid [in the range of about 0.001 to 30% by weight per total weight] and a base selected from the group consisting of hydrocarbon gel, petrolatum and a mixture thereof without any other additive for said acetyl salicylic acid and wherein the ointment does not contain water for dissolving said acetyl salicylic acid,

wherein when the base is hydrocarbon gel or a mixture of hydrocarbon gel and petrolatum, the acetyl salicylic acid is in a range of 20 to 30% by weight per total weight, and wherein when the base is petrolatum, the acetyl salicylic acid is in a range of 25 to 30% by weight per total weight.

Claims 26 and 27 have been added.